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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/434,708 11/05/99 BAND

H B0801/7159(E)

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HM22/1025

EXAMINER

EWOLDT, G

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

10/25/00

9/10

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.  
**09/434,708**

Applicant(s)  
**Waban et al.**

Examiner  
**Gerald Ewoldt**

Group Art Unit  
**1644**



☒ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-7, 9, 11, 12, 17, 21, 22, 25, 34, 50, 52-54, 60, and 61 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-7, 9, 11, 12, 17, 21, 22, 25, 34, 50, 52-54, 60, and 61 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ Fax Transmittal Form.

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### DETAILED ACTION

1. Claims 1-7, 9, 11-12, 17, 21-22, 25, 34, 50, 52-54, and 60-61 are pending.

2. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4315. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

3. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-7, 9, 11, and 50, drawn to a nucleic acid, expression vector, host cell, and pharmaceutical composition, classified in Class 435, subclasses 252.3, 320.1 and Class 424, subclass 278.1.

II. Claims 12, 21, and 50, drawn to a polypeptide, and a pharmaceutical composition, classified in Class 424, subclass 278.1 and Class 530, subclass 350.

III. Claim 17 and 22, drawn to a binding polypeptide and kit, classified in Class 435, subclasses 7.1 and 810.

IV. Claim 22, drawn to a kit comprising a nucleic acid binding agent, classified in Class 435, subclasses 6 and 810.

V. Claim 25 and 52, drawn to method of determining cbl-SL expression using a nucleic acid, classified in Class 435, subclass 6.

VI. Claim 25 and 52, drawn to method of determining cbl-SL expression using an antibody, classified in Class 435, subclass 7.1.

VII. Claims 34, drawn to method of screening for carcinoma, classified in Class 435, subclass 6.

VIII. Claims 53, drawn to method of increasing cbl-SL expression with a nucleic acid, classified in Class 424, subclass 93.1.

IX. Claim 53, drawn to method of increasing cbl-SL expression with a polypeptide, classified in Class 424, subclass 278.1.

X. Claim 54 and 60, drawn to a method of downregulating tyrosine kinase expression, classified in Class 514 subclass 21.

XI. Claim 61, drawn to method for identifying compounds that regulate cbl-SL expression, classified in Class 435, subclass 7.1.

4. Inventions I-IV are different products. They are distinct because their structures and/or modes of action are different. The nucleic acid of Invention I is related to the polypeptide of Invention II by virtue of encoding same. However, nucleic acids and polypeptides are physically and functionally distinct chemical entities. The proteins/binding agents of Inventions III and IV have different functions. Therefore, Invention I-IV are patentably distinct.

5. Inventions I and V/VII/VIII are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)).

In the instant case, the products as claimed can be used in materially different processes, such as for a hybridization probe.

6. Inventions II and IX/X/XI are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)).

In the instant case, the product as claimed can be used in materially different processes, such as affinity purification or as an antigen for antibody production.

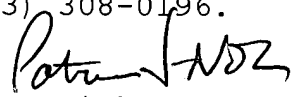
7. The method of Claim VI, using an antibody, is unrelated to the methods of Claims V/VII/VIII, using a nucleic acid, and Claims IX/X/XI, using a polypeptide.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

10. Any inquiry concerning this communication from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday from 7:30 am to 5:30 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

G.R. Ewoldt, Ph.D.  
Patent Examiner  
Technology Center 1600  
October 24, 2000

  
Patrick J. Nolan, Ph.D.  
Primary Examiner  
Technology Center 1600